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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|-------------------|
| 09/775,387 | 01/31/2001 | Herbert F. Cattell | 10010009-1 | 7825 |
| 22878 | 7590 | 04/01/2004 | EXAMINER | |
| AGILENT TECHNOLOGIES, INC. INTELLECTUAL PROPERTY ADMINISTRATION, LEGAL DEPT. P.O. BOX 7599 M/S DL429 LOVELAND, CO 80537-0599 | | | | ALLEN, MARIANNE P |
| ART UNIT | | PAPER NUMBER | | |
| | | 1631 | | |
| DATE MAILED: 04/01/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-------------------|---------------------|--|
| Application No. | 09/775,387 | |
| Examiner | CATTELL, HERBERT F. | |
| Marianne P. Allen | Art Unit 1631 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-11,13,25,27-30,32,33 and 40-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-3,5-11,13,25,27-30,32,33 and 40-45 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20040225.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/12/03 has been entered.

Claims 1-3, 5-11, 13, 25, 27-30, 32-33, and 40-45 are under consideration.

Applicant's arguments filed 11/12/03 have been fully considered but they are not fully persuasive.

Claim Rejections - 35 USC § 112

Claims 1-3, 5-11, 13, 25, 27-29, 32-33, and 40-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9, and 30 recite "information on the function of a target of the array or its complement."

Claim 6 is confusing in that claim 1 already appears to require the association set forth in this claim. As such, it appears that the claim is not further limiting. Clarification is requested. Note that claim 28 has been amended to recite the same language that appears to be redundant to step (c) of this claim. Clarification is requested.

Claim 9 is confusing in containing a period (“.”) in the middle of the claim. This appears to have been an editing error.

Claims 32-33 remain confusing in not clearly further limiting the apparatus of claim 30. The limitations of these claims concern the data communicated but do not further define the apparatus, particularly the processor, of claim 30.

Applicant argues that claims 32-33 do further define the processor. This is not agreed with as the type of data being processed doesn’t change nor is a new piece of data required to be processed.

Claims 30 and 40 are confusing in reciting “indication of a suspected feature error.” It is not known what information must be communicated to meet this limitation. The meets and bounds of what is intended do not appear to be disclosed. Applicant is improperly reading limitations from the specification into the claims. Furthermore, these are non-limiting examples and do not define what the claim is intended to embrace.

Claims 40-43 and 44 are confusing in referring to the method of a preceding claim when the claims upon which they ultimately depend (claims 25 and 30) are directed to apparatus.

Claim Rejections - 35 USC § 102

Claims 1-3, 5-11, 13, 25, 27-29, 37-39, and 44-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Muraca (U.S. Patent Application Publication No. 2002/0168639).

This rejection is maintained for reasons of record.

Claims 1, 9, and 25 as amended require “wherein the retrieval of the biological function data includes: communicating the identifier signal to a processor which retrieves data on the identity of the biopolymers based on the read identifier; and communicating the identity data on

the biopolymers to a processor which retrieves the biological function data for one or more of the biopolymers from a memory based on the retrieved identity data.” This limitation is met by Muraca as one of ordinary skill in the art would recognize recovery of the biological function data from the appropriate relational databases would require such communication to a processor. See at least paragraphs [0028-0030].

Claim 28 as amended requires that “the processor associates information obtained from reading the array with the retrieved biological function data.” Muraca clearly associates such information.

Applicant argues that a tissue array is not embraced by the claims. However, page 8 of the specification indicates that an array “includes one, two or three dimensional arrangement of addressable regions bearing a particular chemical moiety.” Again on page 8, the specification indicates that an array is addressable if it has multiple regions of different moieties such that a region at a particular predetermined location on the array will detect a particular target. The tissue arrays of Muraca meet these definitions.

Claims 1-3, 5-11, 13, 25, 27-29, 37-39, and 44-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Doung et al. (U.S. Patent Application Publication 2002/0177135).

This rejection is maintained for reasons of record.

Claims 1, 9, and 25 as amended require “wherein the retrieval of the biological function data includes: communicating the identifier signal to a processor which retrieves data on the identity of the biopolymers based on the read identifier; and communicating the identity data on the biopolymers to a processor which retrieves the biological function data for one or more of the

biopolymers from a memory based on the retrieved identity data.” This limitation is met by Doung et al. as one of ordinary skill in the art would recognize recovery of the biological function data from the appropriate databases would require such communication to a processor. See at least paragraphs [0330-0358].

Claim 28 as amended requires that “the processor associates information obtained from reading the array with the retrieved biological function data.” Doung et al. clearly associates such information.

Claims 1-3, 5-11, 25, 27, 29, 37-39, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Schembri (GB 2,319,833).

This rejection is maintained for reasons of record.

Claims 1, 9, and 25 as amended require “wherein the retrieval of the biological function data includes: communicating the identifier signal to a processor which retrieves data on the identity of the biopolymers based on the read identifier; and communicating the identity data on the biopolymers to a processor which retrieves the biological function data for one or more of the biopolymers from a memory based on the retrieved identity data.” This limitation is met by Schembri as one of ordinary skill in the art would recognize recovery of the biological function data from the appropriate linked and tagged files would require such communication to a processor. See at least pages 6 and 11.

Claim 28 as amended requires that “the processor associates information obtained from reading the array with the retrieved biological function data.” Schembri clearly associates such information.

Claims 25, 28, and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellson et al. (US 2002/0086319 A1).

Ellson et al. teaches an apparatus comprising an array reader which can read an identifier carried on the array and a processor which retrieves biological function data associated with one or more of the biopolymers based on an identifier. The biopolymers can be polynucleotides. See at least abstract, claims, and figures. Ellson et al. has priority to 13 November 2000 for this disclosure. Note that the array reader would be capable of reading the array before or after exposure. The array reader is not altered.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marianne P. Allen
Marianne P. Allen
Primary Examiner
Art Unit 1631

3/31/04